

### **REMARKS**

This is intended to be a complete response to the Official Action mailed June 6, 2007, in which claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132 and 184-195 were rejected. Claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132-135 and 184-195 have been cancelled without prejudice. New claims 196-224 have been added in substitution for the claims cancelled herein. Paragraph 0033 of the specification has been amended.

### **Rejections under 35 U.S.C §112**

Claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132 and 184-195 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Paragraph 0033 of the specification has been amended without prejudice to delete the term "comprising an absorbent material". Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C §112, paragraph 1.

### **Double Patenting**

Claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132 and 184-195 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 21 of copending Application No. 11/404,416.

Submitted herewith is a terminal disclaimer over U.S. Serial No. 11/404,416, thereby mooting the double-patenting rejection.

### **Claim Rejections under 35 U.S.C §103**

Claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132 and 184-195 stand rejected under 35 U.S.C §103(a) as being unpatentable over Yanus et al. Similarly claims 83-86, 88, 92, 95-98, 101, 104, 107-115, 117, 120-125, 127-128, 132 and 184-195 stand rejected under 35 U.S.C §103(a) as being unpatentable over Badesha et al. (USP 4,855,201).

In the rejection it is stated:

"Yanus et al. [and Badesha et al.] teach in column 12 lines 17+ polysiloxanes are transparent materials and are employed in 10-75% solutions, where the balance of the solution has been read on the claimed "solvent". Examples IV, VI, VII etc. the formation of a 200 Angstrom siloxane layers which have been read on the claimed layer of "...less than 0.0001 inch". Column 6 lines 24+ teach the use of strong mineral acids. The claimed language "... applicator device is a pen or is pen-like" is sufficiently broad that it has been read on the means by which the 200-Angstrom layer was formed.

Yanus et al. [and Badesha et al.] are silent to the claimed "body, a reservoir within the body and integral to the body, and an applicator end..." to contain the polysiloxanes.

Applicant states in paragraph [0034] of the instant disclosure, applicator pens, such as the "PAP Pen" are well known in the art. Pen applicators are advantageous because they are inexpensive, light weight, small in size, can be used easily, do not require specialized training for the technician and do not require additional expensive complex equipment to control the application.

It would have been within the skill of the art to modify Yanus et al. [and Badesha et al.] and use a well-known type of applicator, such as a pen applicator, to gain the above advantages."

The rejection is respectfully traversed on the basis that the examiner has not demonstrated the *prima facie* obviousness of the suggested modification of the references.

Submitted herewith is a declaration of Paul N. Gardner, Jr., under 37 C.F.R. §1.132 wherein it is stated that:

"Bird film applicators were developed by Bird & Sons of East Walpole, MA as a laboratory instrument for the purpose of drawing down coatings in a consistent manner on a flat substrate such as charts mounted on glass. They are precision instruments made of rigid metal, typically tool steel, machined with a designated gap along the longitudinal axis of its bottom side. These applicators have always been made of rigid metal for the reason that all precision would be lost were the material to flex in any way."

Bird-type applicators are in the industry utilized to apply thin wet films or layers of liquid materials to various surfaces. The Badesha et al. and Yanus et al. references teach applying a thin layer of a silicon or polysiloxane material to a surface using the Bird applicator, which has a narrow milled portion which spreads the material in a consistent layer over the surface.

Bird-type applicators, as is well known in the art, are constructed from hard metals such as stainless steel (with or without a nickel chrome finish) or aluminum. The "applicator end" of the Bird applicator is not a "tip" as such but is essentially just a gap along a longitudinal axis of the lower side of the Bird applicator which is formed by machining (see Gardner Declaration). Bird-type applicators are designed to be "precision" devices which apply coatings of thin films having uniform thicknesses across the

coating (see Gardner Declaration). The liquid material to be applied to the substrate is generally placed in front of the milled gap of the Bird applicator and the Bird applicator is drawn or pushed across the substrate, thereby forming the coating of uniform thickness.

The rejection in the official action implies that it would be obvious to take a Bird applicator and modify it with a swab, brush, or rubber material to make the claimed invention, however, a manufacturer of Bird applicators would not do this because a Bird applicator constructed in such a manner would be useless for the purpose intended for a Bird applicator (i.e., to consistently apply a thin uniform layer).

A person of ordinary skill in the art of manufacturing Bird-type applicators would not manufacture a Bird applicator with a brush, swab, or rubber material in the applicator end tip since (1) such a tool would be flexible and thus could not provide a thin film layer of consistent uniform thickness, and (2) such a tool could not withstand repeated uses without the applicator end (tip) being subjected to damage, such as nicks, erosion, or tears. If the applicator end of a Bird-applicator was made with a tip made of a swab, brush, or rubber as claimed in the application, not only would it be flexible, contrary to industrial requirement as stated in the Gardner Declaration, it would very likely be eventually damaged and thus would not

apply a consistent uniform thickness as is required by industrial users of Bird-type applicators.

The evidence provided herein thus demonstrates that contrary to the Examiner's assertions in the rejections of the official action, a person of ordinary skill in the art would not construct a Bird-type applicator to have an applicator end tip constructed with a swab, brush, or rubber material.

The Courts (as explained in the MPEP below) have clearly established that a proposed modification to a prior art reference cannot render the prior art unsatisfactory for its intended purpose.

As stated in MPEP §2143.01(V):

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable

for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).”

The modification proposed by the examiner, i.e., adding a swab, brush, or rubber material to a Bird applicator would render the so-modified Bird applicator unsatisfactory for its intended use by making portions of it flexible, as demonstrated by the Declaration of Paul N. Gardner, Jr., since making such a modification would introduce unacceptable flexibility in the device, contrary to MPEP §2143.01(V).

Further, the Courts have established that a proposed modification to the prior art cannot change the principle of operation of a reference, as stated in MPEP §2143.01(VI):

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of

the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.)."

The prior art references inherently use the Bird applicators due to their inflexibility wherein the device of the present invention would have a flexible portion (a swab, brush, or rubber material) which goes directly against the operational principle of the Bird applicator, thus teaching away from the modification suggested by the examiner which is contrary to MPEP §2143.01(VI).

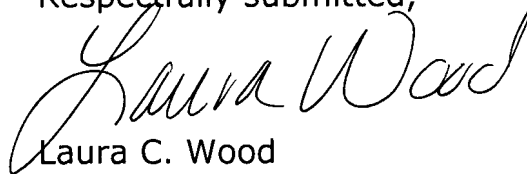
In view of the above, it is apparent that, contrary to the assertions in the rejections under 35 U.S.C. §103(a), a *prima facie* case for obviousness has not been established. The modifications proposed by the examiner are contrary to the necessary design and operation of the Bird applicator devices of the prior art references and thus a person having ordinary skill in the art would not be motivated, and indeed would be averse, to making such modifications.

Applicant therefore respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

**CONCLUSION**

In view of the above, Applicant respectfully suggests the claims are now in a condition for allowance and requests issuance of a Notice of Allowance thereof.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Laura Wood", written in a cursive style.

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